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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,060	12/04/2003	Kelly Tidwell	5983P002	7669

8791 7590 11/14/2005

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EXAMINER

KIM, YOON YOUNG

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/728,060	TIDWELL, KELLY	
	Examiner	Art Unit	
	Yoon-Young Kim	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0405,0305,0105</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "52" has been used to designate both the inner periphery of the can-like housing and filter element. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: outer diameter (50) on the inner periphery of the can-like housing and bypass valve body (78). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8, 10-15, 17, 19, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox, U.S. Patent No. 5,888,383 in view of Faria, U.S. Patent No. 5,066,391.

Regarding Claim 8, Cox discloses a reusable filter having an internally threaded first opening (#7) at one end thereof for threading onto a filter mount on an engine, at least one second opening (#9) adjacent the first opening, and a face seal (#15) circumscribing the first and second openings for sealing against a filter mount, and a filter element (#30) therein, comprising: a can-like body (#3); a tubular woven metal mesh filter element (Col. 3, Lines 52-54); a cap (#2) having the first (#7) and second (#9) openings therein, the second openings being distributed around the first opening; and a face seal (#15) on the cap; the cap being removeably assembleable to the can-like body (Fig. 1); the tubular woven metal mesh filter element fitting within the enclosure defined by the can-like body and the cap and being imposed in the oil flow path between the first and second openings. However Cox does not disclose the shape of the second openings. Faria discloses a reusable oil filter comprising annular arc segment openings (Fig. 1, #48) distributed around a first opening (#50). It would have been obvious to one of ordinary skill in the art to modify Cox with the element of Faria because they are both reusable oil filters. Furthermore, the annular arc segment shapes have no mechanical function and cannot be relied upon to patentably distinguish the claimed invention from the prior

Art Unit: 1723

art. In re Seid, 73 USPQ 431 (1947). The openings of Cox are deemed to be a structure equivalent to the annular arc segment openings of the invention.

Regarding Claim 10, Cox discloses that the woven metal mesh filter element is pleated (Col. 5, Lines 32-34).

Regarding Claims 11 and 22, Cox discloses that the tubular woven metal mesh filter element has a closure member (Fig. 1, 32) permanently attached to a first end thereof, the tubular woven metal mesh filter element being assembleable in the reusable filter with a second end (#21) thereof facing the cap.

Regarding Claims 12 and 23, Cox discloses an o-ring (#18) sealing the second end of the tubular woven metal mesh filter element against an inner surface of the cap.

Regarding Claim 13, Faria discloses that the cap (#40) and can-like body (#20) screw together.

Regarding Claims 14-24, Faria discloses an o-ring seal (#44) between the cap and the can-like body.

Regarding Claims 15-25, Cox discloses that the face seal on the cap is an o-ring (Col. 3, Lines 25-28).

Regarding Claim 17, Cox discloses a bypass valve (#37) responsive to a predetermined pressure difference between the outer periphery and inner periphery of the filter element.

Regarding Claim 19, Cox discloses a reusable filter having an internally threaded first opening (#7) at one end thereof for threading onto a filter mount on an engine, at least one second opening (#9) adjacent the first opening, and a face seal (#15) circumscribing the first and second openings for sealing against a filter mount, and a filter element (#30) therein, comprising: a can-like body (#3); a tubular woven, pleated metal mesh filter element (Col. 5, Lines 32-34); a bypass valve (#37) responsive to a predetermined pressure difference between

Art Unit: 1723

the outer periphery and inner periphery of the filter element; a cap (#2) having the first (#7) and second (#9) openings therein, the second openings being distributed around the first opening; and a face seal (#15) on the cap; the cap being removeably assembleable to the can-like body (Fig. 1); the tubular woven, pleated metal mesh filter element fitting within the enclosure defined by the can-like body and the cap and being imposed in the oil flow path between the first and second openings. However Cox does not disclose the shape of the second openings or screw threads on the cap and body. Faria discloses a reusable oil filter comprising annular arc segment openings (Fig. 1, #48) distributed around a first opening (#50) and the cap (#40) being assembled to the can-like body (#20) by screw threads. It would have been obvious to one of ordinary skill in the art to modify Cox with the element of Faria because they are both reusable oil filters. Furthermore, the annular arc segment shapes have no mechanical function and cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (1947). The openings of Cox are deemed to be a structure equivalent to the annular arc segment openings of the invention.

4. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 8 and 19 above, and further in view of Deibel et al., U.S. Patent No. 6,221,242 B1.

Regarding Claims 9 and 21, Cox in view of Faria does not disclose the material of the filter element. Deibel teaches a stainless steel woven metal filter element (Col. 6, Lines 34-37). It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Deibel because they are reusable oil filters and because it is a material of manufacture common in the filter art.

Art Unit: 1723

5. Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 8 and 19 above, and further in view of Tettman et al., U.S. Patent No. 5,679,244.

Regarding Claims 16 and 26, Cox in view of Faria discloses an o-ring (Cox, #19; Faria, #60) at the second end of the filter element but does not disclose another o-ring at the other end. Tettman teaches an oil filter comprising an o-ring (Fig. 4, #44) at the other end of the filter element against a bottom surface of the can-like body. It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Tettman in order to prevent liquid from traveling through the housing without passing through the filter media (Col. 2, Lines 58-60).

6. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Faria as applied to Claims 8 and 19 above, and further in view of Smith et al., U.S. Patent No. 5,569,373.

Regarding Claims 18 and 20, Cox in view of Faria does not disclose an insert fitting. Smith teaches a reusable oil filter comprising an internally and externally threaded insert fitting (#16). It would have been obvious to one of ordinary skill in the art to modify Cox in view of Faria with the element of Smith in order to allow the filter to be adapted to a wide variety of engines produced by various manufactures (Col. 3, Lines 11-17).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yoon-Young Kim whose telephone number is (571) 272-2240. The examiner can normally be reached on 8:30-4:30, Mon-Fri.

Art Unit: 1723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YK
11/09/05


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